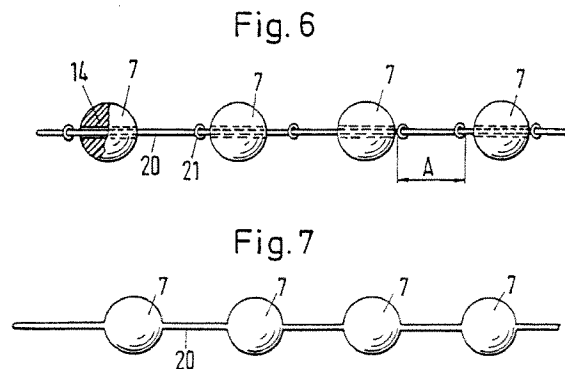
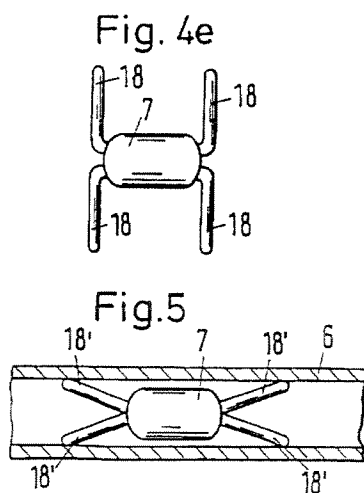


**REMARKS**

Reconsideration of the rejection set forth in the Final Office Action dated October 8, 2008, is respectfully requested. Claim 12 has been amended to require the implant consists essentially of a flexible device having a structure with at least two appendages. No new matter was added with this amendment.

Claims 12, 13, and 16-18 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Baumgartner (USP 5,702,454). These rejections should be withdrawn for the following reasons.

The Examiner has taken the position that it would have been obvious to one of ordinary skill in the art “to modify at least the ‘last support member’ of the implant chain (i.e., the last element 7 in the implant of fig. 6 or 7), so that it has a flexible device as claimed. Such a modification would prevent the implant from leaving the intradiscal space through the aperture that had accommodated the elongate tubular member.” (Office Action, page 3-4)



Applicant has amended claim 12 to require “*the implant consists essentially of a flexible device having a structure with at least two appendages ....*” (See *PPG Industries v. Guardian Industries Corp.*, 156 F.3d 1351, 1354 (Fed. Cir. 1998)) “Typically, ‘consisting essentially of’ precedes a list of ingredients in a composition claim or a series of steps in a process claim. By using the term ‘consisting essentially of,’ the drafter signals that the invention necessarily includes the listed ingredients and is open to unlisted ingredients that do not materially affect the basic and novel properties of the invention.”) Therefore, the method of amended claim 12 requires that the implant includes a structure with at least two appendages and excludes an implant that has numerous other support members linked to the structure as shown in Figs. 6 and 7 of Baumgartner and as contemplated by the Examiner.

Furthermore, Applicant respectfully argues that one of ordinary skill would not have been motivated to modify the last support member of the implants of Figs. 6 or 7 to include the device of Figs. 4e or 5. Baumgartner teaches two alternative retention mechanisms to retain the implants in the cavity - the single chain implant or the support member with the elastically deformable expansion elements.

The chain shape of the support members has firstly the advantage that a support member in a chain can not easily leave the central cavity through an aperture and secondly that during filling the operation can not be reversed without great time loss by withdrawing the chain. A similar retention action can be achieved on individual support members having elastically deformable expansion elements, which during insertion through the tube are deformed in the longitudinal direction and during entry into the central cavity spring back and assume a larger cross section.

Col. 2, lines 27-36. There is no suggestion to use the support member with the elastically deformable elements in combination with the single chain implants. In fact, Baumgartner

emphasizes that one of the advantages of the single chain implant is that it “can not easily leave the central cavity through an aperture.” Therefore, there is no need to modify the last support member of the single chain implant to include the deformable expansion elements because that implant does not suffer the problems of individual, separately-insertable support members leaving the cavity.

Claim 12 is therefore patentably distinct from the cited references. Each of claims 13 and 16-18 are dependent on claim 12 and therefore are patentably distinct from the cited references for the same reasons applicable to claim 12. The rejections under § 103 should therefore be withdrawn.

For all the foregoing reasons, Applicant asserts the claims are in condition for allowance. Favorable action on the merits of the claims is therefore earnestly solicited. If any issues remain, please contact Applicant’s undersigned representative at (949) 760-9600. The Commissioner is hereby authorized to charge any additional fees that may be required to Deposit Account No. 50-2862.

Respectfully submitted,  
O’MELVENY & MYERS LLP

Dated: December 8, 2008

By: *Diane K. Pang*  
Diane K. Pang  
Reg. No. 54,550

610 Newport Center Drive, 17<sup>th</sup> Floor  
Newport Beach, CA 92660-6429  
(949) 760-9600